

REMARKS/ARGUMENTS

Claims 1-16 are pending in this application. No claims are amended, canceled, or added. Therefore, claims 1-16 are present for examination, and claims 1, 11, and 16 are the independent claims.

The Office Action dated July 26, 2006 ("Office Action") rejected claims 1, 6, 11 and 16 under 35 U.S.C. § 102(e) as anticipated by the cited portions of U.S. Patent No. 6,289,347 to Giroux ("Giroux"). Claims 2-3, 5 and 15 are rejected under 35 U.S.C. § 103(a) as unpatentable over Giroux in view of the cited portions of U.S. Patent Publication No. 2006/0012473 A1 to Bishop et al. ("Bishop"). Claims 4, 7-10 and 12-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of Giroux and further in view of the cited portions of U.S. Patent No. 5,799,285 to Klingman et al. ("Klingman"). Applicants respectfully request reconsideration.

35 U.S.C. §102(e) Rejection, Giroux

The Office Action rejected independent claims 1, 11 and 16 under 35 U.S.C. § 102(e) as anticipated by Giroux. For a valid anticipation rejection, the Office must show that each limitation from the claims appears in a single piece of prior art. Applicants believe significant limitations from independent claims 1, 11, and 16 are neither taught nor suggested in the references. More specifically, the references cannot be relied upon to teach or suggest 1) "receiving an identifier in response to a request to audit a form" or 2) "verifying whether the form identifier is a valid form identifier for the form to be audited," as recited in claim 16. Similar limitations are also found in independent claims 1 and 11.

The Office Action relies on Giroux to teach these limitations (Office Action, p. 3, ll. 18-22, *citing* Giroux, col. 3, ll. 30-36; col. 6, ll. 10-31). However the Giroux reference merely describes a system for caching HTML forms for more efficient delivery (Giroux, Abstract, ll. 16-17; col. 4, ll. 51-52). A "host or server system ... [acts] as a forms repository for user systems. Intermediate systems maintain libraries of HTML forms. Database requests are made by a user utilizing a standard Web browser. A database query is transmitted to a server system where it is

processed. The response to the query is transmitted back to the intermediate system. The intermediate system will then check to see if it currently has the appropriate form matching the query response. If not, the form is requested from the server system." (*Id.*, col. 3, ll. 30-38).

The Giroux system, therefore, essentially comprises a method of caching HTML forms at an intermediate system (i.e., the intermediate system and its local forms database; Giroux., col. 4, l. 62; col. 5, l. 6; col. 6, ll. 19-23; FIG. 1, Ref. Num. 74). A particular "form and version number" are requested, and this intermediate (GEAP) system checks to see if there is a locally cached version of the form (*Id.*, col. 6, ll. 19-28). If not, it retrieves the form by requesting it from the server 60. The reference states that this "... 'efficient' mode of operation significantly reduces the amount of bandwidth required to transmit data across the Internet, and ... allows for significantly greater throughput" (*Id.*, col. 4, ll. 59-64). Thus, the intermediate caching system of Giroux tries to *locate* an identified form locally so as to allow more efficient delivery.

But this HTML form caching system described above is clearly quite different than forms auditing system of the claims. Although it is unclear, it appears that the Office Action is equating the attempt by the intermediate system to *locate* a locally cached form in Giroux with the a forms audit of the claims. However, the audit of the claims determines whether there is a *valid* form identifier. An attempt to *locate* a cached version of a form clearly differs from a determination of whether a particular version of a form is *valid*. Giroux therefore fails to teach, "receiving an identifier *in response to a request to audit a form*," as recited in claim 16.

Moreover, claim 16 further recites "verifying whether the form identifier is a valid form identifier for the form to be audited." Again, Giroux fails to teach or suggest the determination of whether a form or its identifier is valid. Instead, the intermediate system simply attempts to locate a particular form cached in a local database to provide more efficient delivery. The claimed forms auditing is absent from Giroux - the lookup of a locally cached version of a form is different than verifying a valid form identifier in auditing a form.

In light of the foregoing, Applicants respectfully submit that the specified limitations in independent claims 1, 11, and 16 are allowable for at least the foregoing reasons. Claims 2-10, and 12-15 each depend from these independent claims, and are believed allowable for at least the same reasons as given above. Applicants respectfully request that the rejections to claims 1-16 under 35 U.S.C. §§102(e) and 103(a) be withdrawn.

35 U.S.C. §103(a) Rejection, Giroux, Bishop, Klingman

Claims 2-3, 5 and 15 are rejected under 35 U.S.C. §103(a) as unpatentable over the cited portions of Giroux and further in view of Bishop. As a threshold matter, a *prima facie* rejection has not been properly set forth for these claims. Cites to Bishop are not proper, as this reference is not prior art. Bishop is a Patent Publication with a filing date of December 9, 2004. The present application was filed December 26, 2001.

To set forth a proper *prima facie* case, a cite to actual prior art is required. While Bishop is a CIP to a number of earlier patents, the only proper citation is to a parent with an earlier priority date, and in which a cited limitation is found. Should further action be warranted for this case, a non-final action properly setting out a proper *prima facie* rejection is respectfully requested. Applicants respectfully request that the rejections to claims 2-3, 5 and 15 under 35 U.S.C. § 103(a) be withdrawn on these grounds as well.

CONCLUSION

For at least the foregoing reasons, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "MLDyk", is written over the typed name.

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